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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,750	07/02/2003	Franklin H. Valade JR.	C4-1184	5548

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EXAMINER

LIEU, JULIE BICHNGOC

ART UNIT	PAPER NUMBER
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2636

DATE MAILED: 04/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/612,750	VALADE ET AL.	
	Examiner	Art Unit	
	Julie Lieu	2636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 49-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/203</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action in response to Applicant's election filed 1/18/05. Group I which consists of claims 1-48, has been elected.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5, 8-9, 13-14, 16-17, 23, 25, 26-27, 29, 33-35, 36, 41, 43, 45, and 46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-9, 10, 12, 14, 13, 12, 51, 54, 55, 58, 61, 60, 62, 61, 61, 60, 61, and 62 of copending Application No. 10/448992 (US 2004/00239505), respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed matters are substantially the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 and 25-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen et al. (US Patent No. 5,426,419).

Claim 1:

Nguyen et al. (herein after as Nguyen) discloses a security tag, comprising:

- a. a tag housing (fig. 1);
- b. a tack body 4; and
- c. a linear clamp 6 (fig. 5) disposed within said tag housing having a slot 14C' to retain said tack body, and to move in a substantially linear direction in response to a force to release the tack body from said slot.

Claim 2:

The linear clamp 6 comprises:

- a. a clamp body 14;

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- b. a spring arm 17 attached to a first edge of said clamp body; and
- c. a tack retaining body 15, 16 to retain said tack body.

Claim 3:

The tack retaining body 6 comprises a first jaw 15 and a second jaw 16, with each jaw terminating in spaced facing edges 15A, 16A, the spaced facing edges forming a slot and a jaw open area in said clamp body.

Claim 4:

The jaws 15 and 16 extend from a common second edge of said clamp body. See fig. 5.

Claim 5:

Jaws 15 and 16 are integrally formed with clamp body 6.

Claim 6:

The tack body 4 comprises at least one first portion 4B and at least one second portion 4C, the first and second portions having first and second diameters, respectively, with the second diameter smaller than said first diameter.

Claim 7:

The slot 14C' has a width approximate to the second diameter, wherein the jaws move from a first position to a second position to accommodate the first portions, and from second position to the first position to retain the second portion.

Claim 8:

A side of clamp body which is spring arm forms a first plane, and a side of said tack retaining body forms a second plane substantially parallel to said first plane. See fig. 5.

Claim 9:

A first portion of the spaced facing edges are substantially parallel to form the slot, with first end of said slot forming a curve approximating a curve for the tack body, and the second end of said slot forming a release section opening into said jaw open area.

Claim 10:

The tag body includes a channel 7 for a detachment probe 8 , the channel configured to accommodate movement of said detachment probe to contact said first edge of said linear clamp. See front page figure.

Claim 11:

The detachment probe 8 provides force against the second edge to move the linear clamp from a first position to a second position in the linear direction.

Claim 12:

The linear clamp 6 moves from the second position to said first position when said force is terminated.

Claim 13:

A second portion of said spaced facing edges are 15A, 16A straight to form said jaw open area, with a first distance between a first end of said jaw open area being less than a second distance between a second end of said jaw open area. See fig. 5.

Claim 14:

The housing comprises a top half (figs. 4A,B) and a bottom half (fig. 6A,b), with said bottom half having a guide 7A to assist movement of the linear clamp in the linear direction. Fig. 3.

Claim 15:

The bottom half of the tag in Nguyen includes an abutment to bias the spring arm in response to movement of said linear clamp in said linear direction, the abutment being disposed approximately in line with the force.

Claim 16:

The spring arm 17 comprises a spring arm body that extends along said first edge of said clamp body; and a curved joint 18 joining said spring arm body to one end of the clamp body.

Claim 17:

Spring arm 17 moves from a first position to a second position in response to said force, and moves from said second position to said first position when the force terminates.

Claim 18:

The security tag in Nguyen comprising a bridge across said jaw open area.

Claim 19:

Tag body 6 includes a channel for a detachment probe 8, the channel configured to accommodate movement of said detachment probe to contact said bridge.

Claim 20:

The detachment probe 8 provides force against the bridge to move said linear clamp from a first position to a second position in said linear direction. See front page figure.

Claim 21:

The linear clamp 6 moves from the second position to the first position when said force is terminated.

Claim 25:

Nguyen discloses a linear clamp for a security tag, comprising:

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- a. a clamp body 6;
- b. a spring arm 17 attached to a first edge of said clamp body 6; and
- c. a tack retaining body 15, 16 having a slot 14C' to retain the tack body, and to release the tack body from slot 14C' in response to a force applied in a substantially linear direction.

Claim 26:

The tack retaining body comprises a first jaw 15 and a second jaw 16, with each jaw terminating in spaced facing edges 15A and 16A, the spaced facing edges forming slot 14C' and a jaw open area in the clamp body.

Claim 27:

The jaws extend from a common second edge of the clamp body. Fig. 5.

Claim 28:

Jaws 15 and 16 are integrally formed with the clamp body. Fig. 5.

Claim 29:

The clamp body forms a first plane, and a side of said tack retaining body forms a second plane substantially parallel to said first plane. Fig. 5.

Claim 30:

A first portion of said spaced facing edges 15A, 16A are substantially parallel to form slot 14C', with a first end of the slot forming a curve approximating a curve for said tack body, and said second end of said slot forming a release section opening into said jaw open area.

Fig. 5.

Claim 31:

The second edge of said tack retaining body receives force to move said linear clamp from a first position to a second position in linear direction.

Claim 32:

The tack body moves into said jaw open area when said linear clamp is in the second position, thereby releasing the tack body from the tack retaining body. See front page figure.

Claim 33:

The linear clamp in Nguyen moves from the second position to the first position when force is terminated.

Claim 34:

A second portion of said spaced facing edges 15A, 16A are straight to form said jaw open area, with a first distance between a first end of said jaw open area being less than a second distance between a second end of the jaw open area.

Claim 35:

The spring arm 17 comprises a spring arm body that extends along the first edge of said clamp body; and a curved joint 18 joining said spring arm body to one end of said clamp body.

Claim 36:

Spring arm 18 moves from a first position to a second position in response to the force, and moves from the second position to the first position when the force terminates.

Claim 37:

The spring arm 17 is biased approximately in line with the force.

Claim 38:

Clamp 6 in Nguyen further comprises a bridge across the jaw open area.

Claim 39:

The bridge represented by 15A, 16A receives force to move said linear clamp from a first position to a second position in linear direction.

Claim 40:

The tack body 4 moves into the jaw open area when the linear clamp is in said second position, thereby releasing the tack body from the tack retaining body. Front figure.

Claim 41:

The linear clamp 6 moves from the second position to the first position when the force is terminated.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 22-24 and 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US Patent No. 5,426,419).

Claim 22:

A first portion of said spaced facing edges are substantially straight to form said slot 14C'. Slot 14C' appears not to have first and second ends with the second end forming a release section opening into the jaw open area, with the release section having a second width smaller than the first width. Nonetheless, lacking any criticality as to why the slot must have two ends with the release section having a smaller width, how it would produce any unexpected result, or solve any stated problem, it appears that the slot form in Nguyen's is functionally equivalent.

Claim 23:

Tag housing 1 comprises a top half and a bottom half with the bottom half (figs. 4A,B and 6A,B) having a guide 7A to assist movement of said linear clamp in said linear direction. See fig. 3.

Claim 24:

The bottom half includes an abutment 24 to bias said spring arm in response to movement of the linear clamp in linear direction, said abutment being disposed to generate a clockwise moment approximately equal and opposite to a counterclockwise moment caused by the slot.

Claim 42:

The rejection of claim 42 recites the rejection of claim 22.

Claim 43:

A second edge of the tack retaining body receives force to move the linear clamp from a first position to a second position in the linear direction. See front page figure.

Claim 44:

The tack body 4 moves into the jaw open area when the linear clamp is in the second position, thereby releasing the tack body from the tack retaining body.

Claim 45:

Linear clamp 6 moves from the second position to the first position when said force is terminated. See front page figure.

Claim 46:

Spring arm 17 comprises:

- a. a spring arm body that extends along the first edge of the clamp body; and
- b. a curved joint 18 joining said spring arm body to one end of the clamp body.

Claim 47:

Spring arm 17 moves from a first position to a second position in response to the force, and moves from said second position to said first position when the force terminates.

Claim 48:

Spring arm 17 is biased to generate a clockwise moment approximately equal and opposite to a counterclockwise moment caused by the slot.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Damwig, US Patent No. 4,745,664.

Okuno, US Patent No. 6,474,117.

Sayegh et al, US 2003/0222780 A1.

Hogan et al., US 2004/0239505.

Hartings, US 4,774,505.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Lieu whose telephone number is 571-272-2978. The examiner can normally be reached on Maxi Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie Lieu
Primary Examiner
Art Unit 2636

Apr. 1, 05